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REMARKS

This reply is fully responsive to the Office Action dated April 8, 2009, and is filed within TWO (2) months following the mailing date of the Office Action and, as such, warrants an appropriate ADVISORY ACTION. The Commissioner is authorized to treat this
10 response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The method of payment and fees for petition fee due in connection therewith is enclosed if required.

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Objection/Rejection Summary

This application has been carefully reviewed in light of the Office Action of April 8, 2009, wherein:

- 20 A. Claims 1, 4-8, 9, and 12-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman et al. (U.S. Patent No. 6,711,585 B1; hereinafter referred to as the Copperman patent) in view of Adamske et al. (U.S. Patent No. 6,615,234 B1; hereinafter referred to as the Adamske patent);
- 25 B. Claims 3, 11, 17, and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Copperman patent in view of the Adamske patent and further in view of Mahoney et al. (U.S. Patent No. 5,999,664; hereinafter referred to as the Mahoney patent); and
- 30 C. Claims 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Copperman patent in view of the Adamske patent and further in view of Le and Thoma (Automated document labeling using integrated image and neural processing, published in 1999; hereinafter referred to as the Le publication).

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Claim Rejections under 35 U.S.C. §103

A. Claims 1, 4-8, 9, and 12-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Copperman patent in view of the Adamske patent.

10 **Claims 1 and 9**

The Examiner rejected Claims 1 and 9 as being unpatentable over the Copperman patent in view of the Adamske patent. The Applicants respectfully point out that establishing a *prima facie* case of obviousness requires: (A) determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims in issue;

15 (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations. *See Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Proper analysis of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. 35 U.S.C. 103(a). Recently, the Supreme Court stated that “[R]ejections on obviousness
20 cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) *quoting In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

25 The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F. 3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006).

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Additionally, in order to establish a *prima facie* case of obviousness of a claimed invention, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

5 Regarding Claims 1 and 9, the Examiner stated that the Adamske patent teaches the conversion of electronic documents into PostScript files. The Examiner further concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Copperman patent by the teachings of the Adamske patent to include the conversion of electronic documents into PostScript files,
10 because it allows for portability and accessibility across communication networks and machines.

The Applicants respectfully assert that the cited prior art references do not teach each of the claim limitations of Claims 1 and 9. Additionally, it would not have been obvious to
15 one of ordinary skill in the art at the time of the invention to combine the Copperman patent and the Adamske patent to arrive at the claimed invention, since the intended purpose of the PostScript file in the present application is distinct from that of the Adamske patent. The Adamske patent describes a document delivery system, wherein a “user uploads an electronic version of a document over the network to the document
20 delivery system where the electronic document is converted to a user-viewable print preview format that is displayed to user at the user’s computer” (Adamske patent, Col. 3, lines 53-59). Furthermore, the Adamske patent teaches, “a conversion software program converts the electronic document from its client application format to a printable format (e.g., a PostScript file). The printable version of the electronic document is then
25 transmitted across a printing network...to a print spooler server” (Adamske patent, Abstract). It is evident that the Adamske patent discloses the conversion of the electronic document into a PostScript file as a final step prior to print previewing and/or printing, which then undergoes no further processing.

30 In contrast, the present application describes the conversion of electronic documents into PostScript files as an intermediate step towards extracting metadata from the PostScript files and output of the metadata. Specifically, Claims 1 and 9 teach the limitations, “said reasoning element is configured to employ a set of rules to automatically extract metadata from the PostScript files by employing the extracted predetermined information-and the
35 input from the database” and “said reasoning element provides an output of metadata.”

5 Therefore, the Applicants assert that the cited prior art does not teach each element of
Claims 1 and 9. Furthermore, it would have not been obvious to one of ordinary skill in
the art at the time the invention was made to have modified the Copperman patent by the
teachings of the Adamske patent to include the conversion of electronic documents into
PostScript files, since the PostScript file of the Adamske patent undergoes no further
10 processing or extraction of metadata, while the PostScript file of the present application is
an intermediate product which undergoes further processing, specifically the automatic
extraction of metadata form the PostScript file which is then output by the reasoning
element.

15 Thus, neither the Copperman patent nor the Adamske patent, either alone or combined,
teaches each of the claimed elements of Claims 1 and 9. Therefore, the Applicants
respectfully request that the Examiner withdraw the rejection of Claims 1 and 9 under 35
U.S.C. §103 and provide for timely allowance of all pending claims.

20 **B. Claims 3, 11, 17, and 19 were rejected under 35 U.S.C. 103(a) as being
unpatentable over the Copperman patent in view of the Adamske patent and
further in view of the Mahoney patent.**

Claims 3 and 11

25 Regarding Claims 3 and 11, the Applicants direct the Examiner to the comments
regarding Claims 1 and 9 above. As noted above, the Applicants believe that Claims 1
and 9 are in allowable condition. Since Claims 3 and 11 depend from Claims 1 and 9,
they incorporate all of the limitations of their respective independent claims, Claims 1
and 9, and therefore, Claims 3 and 11 are patentable for at least the same reasons given
30 with respect to their respective independent claims. Thus, the Applicants respectfully
request that the Examiner withdraw the rejection of Claims 3 and 11 under 35 U.S.C.
§103 and provide for timely allowance of the pending claims.

5 Claims 17 and 19

The Examiner rejected Claims 17 and 19 as being unpatentable over the Copperman patent in view of the Adamske patent and further in view of the Mahoney patent. The Applicants respectfully point out that establishing a *prima facie* case of obviousness requires: (A) determining the scope and contents of the prior art; (B) ascertaining the
10 differences between the prior art and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations. *See Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Proper analysis of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. 35 U.S.C. 103(a).

15 Recently, the Supreme Court stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) *quoting In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

20 The rationale to support a conclusion that the claim would have been obvious is that “a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.
25 3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006).

Additionally, in order to establish a *prima facie* case of obviousness of a claimed invention, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

30 Regarding Claims 17 and 19, the Applicants believe that the Examiner has not set forth a *prima facie* case of obviousness because the Examiner has failed to establish references that, if combined or modified, teach each of the elements disclosed by Claims 7 and 19. The Examiner stated that the Mahoney patent teaches the limitations of (a) an absolute

- 5 line counter order for each string of text and (b) font metrics of bounding box extensions used to represent the string of text.

Regarding the limitation of “an absolute line counter order for each string of text”, the Examiner referenced Column 10, Table 1 of the Mahoney patent as teaching this element.

- 10 However, the referenced section of the Mahoney patent does not disclose “an absolute line counter order for each string of text.” Table 1 of the Mahoney patent describes layout object types and explanations of the layout object types. However, the Applicants have been unable to identify where “an absolute line counter order for each string of text” is taught. The Applicants respectfully request that the Examiner point out, with
15 specificity, where in the prior art the Examiner finds such a limitation. Failing that, the Applicants respectfully submit that Claims 17 and 19 are allowable.

- Regarding the limitation of “font metrics of bounding box extensions used to represent the string of text”, the Examiner referenced Column 27, lines 55-65 of the Mahoney
20 patent as teaching this element. The Mahoney patent describes sorting image segments into similar groups by the use of similar font styles or font sizes. However, the Applicants have been unable to identify where “font metrics of bounding box extensions used to represent the string of text” is taught. The Applicants respectfully request that the Examiner point out, with specificity, where in the prior art the Examiner finds such a
25 limitation. Failing that, the Applicants respectfully submit that Claims 17 and 19 are allowable.

Thus, neither the Copperman patent, the Adamske patent, nor the Mahoney patent, either alone or combined, teaches each of the claimed elements of Claims 17 and 19.

- 30 Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of Claims 17 and 19 under 35 U.S.C. §103 and provide for timely allowance of all pending claims.

5 **C. Claims 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Copperman patent in view of the Adamske patent and further in view of the Le publication.**

Claims 18 and 20

Regarding Claims 18 and 20, the Applicants direct the Examiner to the comments regarding Claims 1 and 9 above. As noted above, the Applicants believe that Claims 1 and 9 are in allowable condition. Since Claims 18 and 20 depend from Claims 1 and 9, they incorporate all of the limitations of their respective independent claims, Claims 1 and 9, and therefore, Claims 18 and 20 are patentable for at least the same reasons given with respect to their respective independent claims. Thus, the Applicants respectfully request that the Examiner withdraw the rejection of Claims 18 and 20 under 35 U.S.C. §103 and provide for timely allowance of the pending claims.

20 CONCLUSION

The Applicants respectfully submit that in light of the above amendment/remarks, all claims are now in allowable condition. The Applicants thus respectfully request timely allowance of all of the pending claims.

25 Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly
30 understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.

5 Further, it should be noted that amendment(s) to any claim is intended to comply with the requirements of the Office Action in order to elicit an early allowance, and is not intended to prejudice Applicant's rights or in any way to create an estoppel preventing Applicant from arguing allowability of the originally filed claim in further off-spring applications.

10 In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicants or Applicants' representative would be beneficial, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

15 The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to the attached credit card form. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of
20 the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 50-2691 if a credit card form has not been included with this correspondence, or if the credit card could not be charged.

25 Respectfully submitted,



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